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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,691	07/06/2001	Hans-Juergen Hauschild	112740-237	6701

29177 7590 10/01/2004

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/900,691	HAUSCHILD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ovidio Escalante	2645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. This action is in response to applicant's amendment filed on April 22, 2004. **Claims 1-12** are now pending in the present application.

#### *Continued Examination Under 37 CFR 1.114*

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 22, 2004 has been entered.

#### *Priority*

3. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bansal et al. US Patent 6,787,749 in view of Picard 6,233,318.

**Regarding claim 1**, Bansal teaches a voice processing apparatus (portable device 100; col. 2, lines 14-30) and method for processing individual voice messages stored in a voice memory system (messaging device 130/database 140; col. 1, lines 26-35; col. 3, lines 12-27), wherein the voice memory system is controllable via the voice processing apparatus (100) using particular signals, (query signals, col. 2, lines 52-59), the voice processing apparatus comprising:

a transmission apparatus for sequentially requesting all individual voice messages stored in the voice memory system via a single input, (col. 2, lines 52-59; col. 3, lines 52-63; a single button may be pressed to request the messages);

a reception apparatus for sequentially receiving the individual voice messages stored in the voice memory system, (col. 3, lines 60-63; col. 4, lines 16-25; col. 6, lines 1-6);

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a memory apparatus for separately storing the individual voice messages in the voice processing apparatus, (col. 2, lines 25-30).

Bansal does not specifically teach of a playback apparatus for randomly playing back the stored messages.

In the same field of endeavor, Picard teaches of a voice apparatus which comprises a playback apparatus for randomly playing back the stored individual voice messages, (col. 3, lines 41-49; col. 13, lines 22-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Bansal by playing back the individual messages randomly as taught by Picard so that the user can hear the messages that have been transmitted to the portable device and so that the user can pick any message without listening to the messages in a specific order.

**Regarding claim 2**, Bansal, as applied to claim 1, teaches a wherein the transmission apparatus automatically generates and sends the particular signals (query signals) required for controlling the voice memory system , (col. 2, lines 51-59).

**Regarding claim 3**, Bansal, as applied to claim 1, teaches of using signals. Bansal does not specifically teach wherein the particular signals are formed based on a dual tone multi-frequency dialing method.

In the same field of endeavor, Picard teaches wherein the particular signals are formed based on a dual tone multi-frequency (DTMF) dialing method, (col. 13, lines 22-33). Picard teaches that DTMF is used to interact with a VMS system.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the signals of Bansal by using dual tone multi-frequency dialing as taught by Picard so that the portable device can interact with the voice messaging system.

**Regarding claim 4**, Bansal as applied to claim 1, teaches a display apparatus, (col. 2, lines 14-30). Bansal does not specifically teach a display apparatus having a graphical user interface for controlling the voice processing apparatus.

In the same field of endeavor, Picard teaches of a display having a graphical user interface for controlling the voice processing apparatus, (col. 7, lines 13-25; fig. 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the display of Bansal by using a graphical user interface as taught by Picard so that the user can interact with the stored messages and can select the messages that appear on the display.

**Regarding claim 5**, Bansal, as applied to claim 1, teaches wherein the stored voice messages are made available to the user. Bansal does not specifically teach that the stored voice messages are made available to the user as a respective attachment to an e-mail.

In the same field of endeavor, Picard teaches wherein the stored voice messages are made available to the user as a respective attachment to an e-mail, (col. 9, lines 28-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the voice message of Bansal by making the voice message available as an attachment to an e-mail as taught by Picard so that the portable device (e.g. laptop) of Bansal can receive voice messages.

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*Regarding claim 6*, Bansal, as applied to claim 1, does not specifically teach of an erasing apparatus for automatically erasing the individual voice message in the voice memory system.

In the same field of endeavor, Picard teaches an erasing apparatus for automatically erasing the individual voice messages in the voice memory system which already have been received, (col. 17, line 66-col. 18, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Bansal by using an erasing apparatus as taught by Picard so that message storage space in the system can be reduced.

*Regarding claim 7*, Bansal teaches a method for processing individual voice messages from a voice memory system (messaging device 130/database 140; col. 1, lines 26-35; col. 3, lines 12-27), wherein the voice memory system is controllable via particular signals (query signals, col. 2, lines 52-63) the method comprising the steps of:

requesting all individual voice messages with a single input, (col. 2, lines 52-59; col. 3, lines 52-63; a single button is pressed);

receiving, sequentially, the individual voice message stored in the voice memory system, (col. 3, lines 60-63; col. 4, lines 16-25; col. 6, lines 1-6);

storing, separately, the individual voice messages, (col. 2, lines 25-30).

Bansal does not specifically teach of a playing back, randomly stored individual messages.

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In the same field of endeavor, Picard teaches of a voice memory system and storing individual voice message and playing back randomly, the stored individual voice messages, (col. 3, lines 41-49; col. 13, lines 22-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Bansal by playing back the individual messages randomly as taught by Picard so that the user can hear the messages that have been transmitted to the portable device and so that the user can pick any message without listening to the messages in a specific order.

**Regarding claim 8**, Bansal, as applied to claim 7, teaches generating and sending, automatically, the particular signals required for controlling the voice memory apparatus, (col. 2, lines 51-59).

**Regarding claim 9**, Bansal, as applied to claim 7, teaches wherein the stored voice messages are made available to the user. Bansal does not specifically teach that the stored voice messages are made available to the user as a respective attachment to an e-mail.

In the same field of endeavor, Picard teaches wherein the stored voice messages are made available to the user as a respective attachment to an e-mail, (col. 9, lines 28-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the voice message of Bansal by making the voice message available as an attachment to an e-mail as taught by Picard so that the portable device (e.g. laptop) of Bansal can receive voice messages.

**Regarding claim 10**, Bansal, as applied to claim 7, does not specifically teach of an erasing, automatically erasing the individual voice message in the voice memory system.



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In the same field of endeavor, Picard teaches an erasing method for automatically erasing the individual voice messages in the voice memory system which already has been received, (col. 17, line 66-col. 18, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Bansal by using an erasing method as taught by Picard so that memory storage space can be reduced.

**Regarding claim 11**, Bansal, as applied to claim 1, teaches wherein the transmission apparatus requests multiple individual voice message stored in the voice memory system by a single request, (col. 2, lines 52-59; col. 3, lines 52-63).

**Regarding claim 12**, Bansal, as applied to claim 7, teaches wherein the receiving step receives sequentially multiple individual voice messages stored in the voice memory system with a single request, (col. 2, lines 52-59; col. 3, lines 52-63).

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bhagal et al. US Patent 6,751,298 teaches of transmitting all voice messages stored on a server to a wireless telephone upon receiving a request from the wireless telephone.

Bobo, II teaches of receiving messages from a messaging system with a single input.

10. Any response to this action should be mailed to:

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Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

220 20<sup>th</sup> Street S.

Crystal Plaza two, Lobby, Room 1B03

Arlington, VA 22202

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE  
PATENT EXAMINER**

Ovidio Escalante  
Examiner  
Group 2645  
September 30, 2004

*Ovidio Escalante*

O.E.